

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Andrej Gregov et al.
App. No	:	09/648,314
Filed	:	August 25, 2000
For	:	USER-DIRECTED PRODUCT RECOMMENDATIONS
Examiner	:	Etienne Pierre Leroux
Art Unit	:	2161
Conf No.	:	6403

RESPONSE TO DECISION ON APPEAL

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is filed in response to the Decision on Appeal mailed April 20, 2010, in connection with the above-identified patent application. In the Decision, the Board of Patent Appeals and Interferences (hereinafter the "Board") reversed the previously entered grounds for rejection of Claims 15-16, 27-31, 45, and 48 under 35 U.S.C. § 102(e) and Claims 32-35, 40-44, 46-47, and 49 under 35 U.S.C. § 103(a). However, the Board entered a new ground for rejection of Claims 15, 16, 27-35, and 40-51 under 35 U.S.C. § 112, first paragraph, because the claimed limitations allegedly do not meet the written description requirement.

In accordance with 37 C.F.R. § 41.50(b), applicants provide additional remarks and evidence relating to the rejected subject matter. As detailed below, applicants respectfully request reconsideration of the rejection of Claims 15, 16, 27-35, and 40-51 under 35 U.S.C. § 112 and allowance of the claims.

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A. Rejection of Claims 15, 16, 27-35, and 40-51 Under 35 U.S.C. § 112, First Paragraph

As indicated above, Claims 15, 16, 27-35, and 40-51 were rejected under 35 U.S.C. § 112, first paragraph, because the recited limitation, "wherein the generated list does not contain the selected seed items," allegedly does not meet the written description requirement. Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 U.S.P.Q.2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 U.S.P.Q. 1089, 1096 (Fed. Cir. 1983)). *See also* M.P.E.P. 2163.02.

As discussed in the Decision on Appeal, applicants previously identified paragraph 5, page 1 in the Specification of the present application for support of the above rejected claim limitation. Paragraph 5, page 1, reads as follows:

By recommending additional products to a user in this manner, a web merchant can often sell a recommended product to a user that would not have otherwise purchased it, thereby generating additional sales and profits for the web merchant. Further, such recommendations services often have utility to the user, identifying items that would be useful to the user and of which the user was previously unaware.

Applicants respectfully disagree with the rejection and believe that the above-cited portion of the Specification reasonably conveys to the artisan that the applicants had possession, at the time of filing, the claimed subject matter.

Nevertheless, applicants further submit that the present application includes additional discussion and teaching that further convey applicants' possession, at the time of filing, the claimed subject matter and thereby satisfy the written description requirement under Section 112, first paragraph. Applicants first to refer to Figure 6 of the present application and the accompanying description on Page 7, first paragraph of the Specification.

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In Figure 6, this list of seed items only includes one seed item, item 691 corresponding to item 550 shown in Figure 5. Figure 6 also shows a list of recommended items 610, 620, 630, 640 and 650. These recommended items are based upon using seed item 691 alone as a seed for the recommendation engine.”

In accordance with the embodiment illustrated in Figure 6, a single seed item 691 is utilized to generate a set of recommendations 610, 620, 630, 640, and 650. Moreover, and as illustrated in Figure 6 (below), none of the recommended items 610, 620, 630, 640, and 650 correspond to the seed item, item 691. Therefore, Figure 6 and its corresponding description clearly convey applicants' possession of the recited limitation “wherein the generated list does not contain the selected seed items.”

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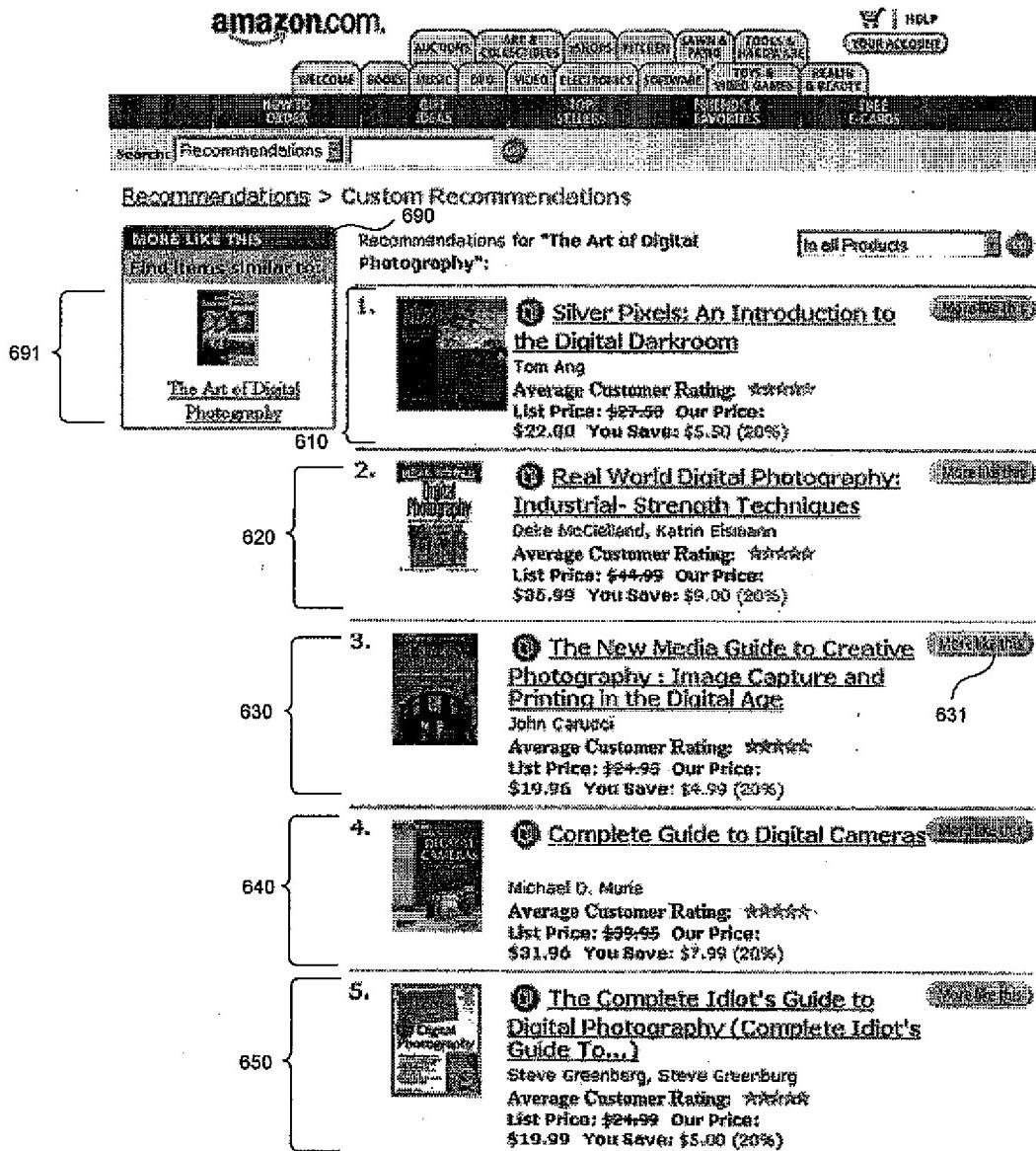


FIG. 6

24976-8045/Fig6.vsd

With reference now to Figure 7, and the accompanying description on Page 7, second paragraph, of the Specification, in a further illustrative embodiment, two seed items are used to generate a revised set of recommended items in manner such that the two seed items are not included as recommended items.

Figure 7 is a display diagram showing the display of a revised set of recommended items based upon an expanded list of user-selected seed items. The display shown in Figure 7 is preferably generated in response to the user clicking on button 631 shown in Figure 6. As a result, the facility has added seed item 793 to the list 790 of the user-selected seed items. The list of recommended items 710, 720, 730, 740, and 750 is correspondingly revised to include items recommended based upon these two seed items.

Similar to the discussion with regard to Figure 7, in accordance with the embodiment illustrated in Figure 7, two seed items 791 and 793 are utilized to generate a set of recommendations 710, 720, 730, 740, and 750. Moreover, and as illustrated in Figure 7 (below), none of the recommended items 710, 720, 730, 740, and 750 correspond to either of the seed item, item 791 and 793. Therefore, Figure 7 and its corresponding description also clearly conveys applicants' possession of the recited limitation "wherein the generated list does not contain the selected seed items."

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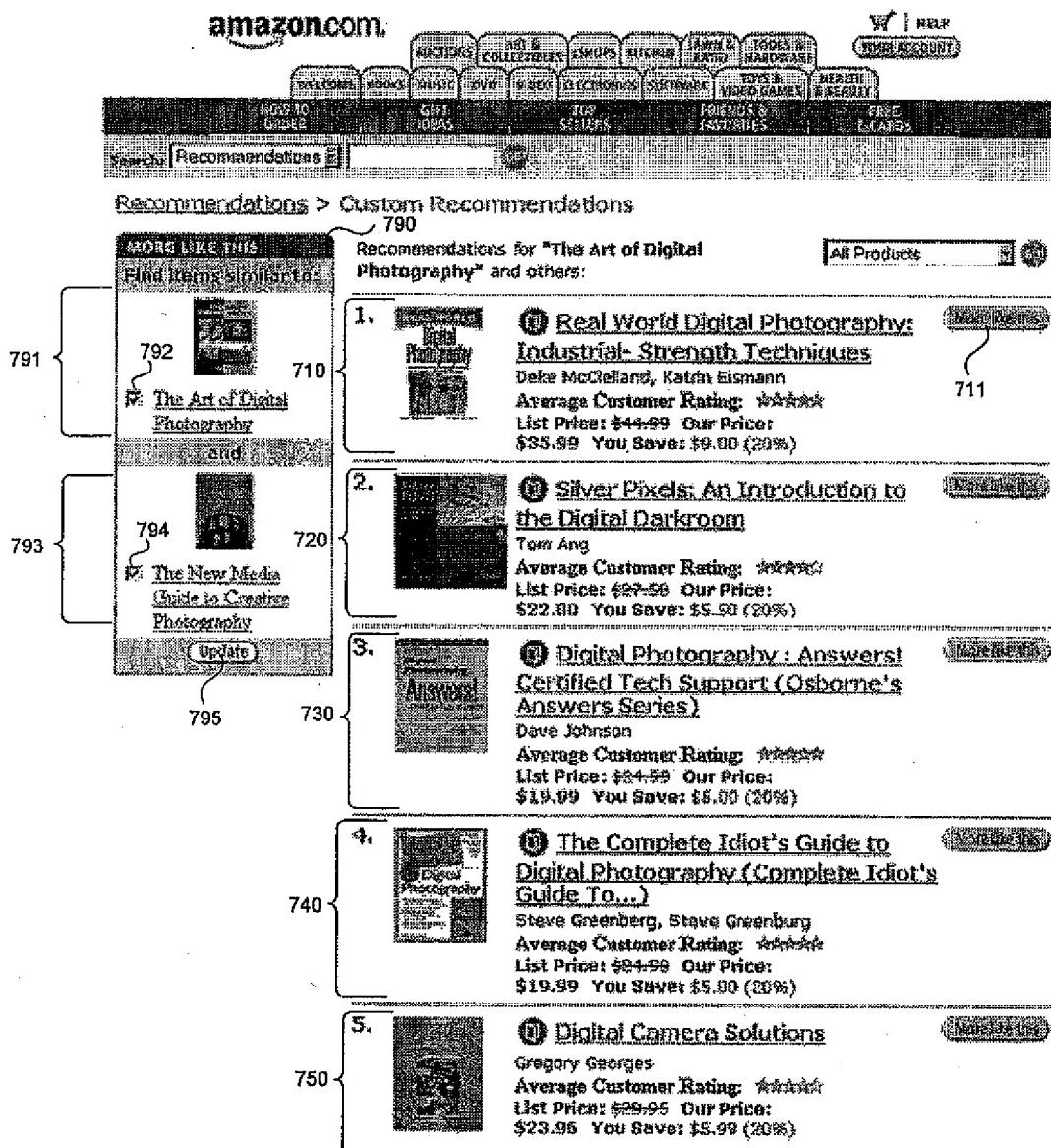


FIG. 7

24976-8045/Fig7.vsd

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Applicants respectfully submit that the above-cited portions of the Specification and drawing figures, individually or cumulatively, convey with reasonable clarity to those skilled in the art that, as of the filing date sought, applicants' were in possession of the subject matter recited in Claims 15-16, 27-35, and 40-51. For at least the reasons discussed above, applicants respectfully request a withdrawal of the Section 112, first paragraph rejection for Claims 15-16, 27-35, and 40-51.

CONCLUSION

Applicants respectfully submit that all of the claims currently pending in this application, Claims 15-16, 27-35, and 40-51, are in condition for allowance. If there are any questions or issues that may be resolved by a telephone interview to expedite allowance of this application, applicants invite the Examiner to call the undersigned attorney of record at the telephone number listed below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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AMEND

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